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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,679	02/08/2002	Thomas S. Kilpela	647 P 067	4180

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EXAMINER

ROBERTS, PAUL A

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 04/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,679

Applicant(s)

KILPELA ET AL.

Examiner

Paul A Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-18-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3-18-03 have been fully considered but they are not persuasive.
2. Applicant contends the Burke '168 reference does not contain a pair of spaced prongs. The examiner has included a diagram showing the pair of spaced prongs.
3. Applicant contends that the Burke device does not contain a pair of spaced sidewalls. There are two sides to item SW in the attached drawing, much the same way there are two sides to any plane. Further applicant's argument that the device does not contain "separate sidewalls" is noted, but is moot since the applicant has not claimed, "separate sidewalls."
4. As shown in figure 1, the jaws are not identical. It is not relevant that the applicant's jaw design differ from each more than the jaws of the Burke design. The jaws of the Burke design are different than that of the applicant's drawings, but fall in the scope of the applicant's claims. The trough has been labeled on the diagram.
5. Regarding the applicant's argument on the intended use of the auxiliary handle. In response to applicant's argument that the use of the auxiliary handle is different in the Nelson '054 reference than in the applicant's invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA

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1963). Also, since the applicant did not claim the length of the handle, arguing whether or not the applicant's auxiliary handle length differs from that of Nelson is not relevant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke 5,545,168. Burke discloses a crimping device comprising the following: a set of pivotally connected handles (fig. 1, 41), each of said handles connecting to one of a pair of interacting jaw portions at an end of each of handles to form a pliers jaw (42) for crushing cable wire crimps (figure 5) positioned between said interacting jaw portions. One of said jaw portions comprises a pair of laterally positioned sidewalls (fig. 1, 62) and a pair of spaced crimp retaining prongs (60), wherein those sidewalls define a crimp space there between (58.) The other side of said jaw portions defines a single crimp gripping and crushing projection that is positioned to move toward said crimp space as the jaw portions are pivoted to a closed, crimp portion.
7. Regarding claims 2 and 4, the prongs define the outer walls of the troughs (fig. 1, item 58.)
8. Regarding claim 3, the crimp space is defined by longitudinally extending troughs (fig 1, 58.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke 5,545,168 in view of Nelson 4,643,054.
10. Regarding claims 5-8, Burke discloses all the limitations of claim 3, but does not disclose the inclusion of an auxiliary handle w/ a limited range of pivotal movement. Nelson teaches a quick squeeze tool with a handle (50, figure 6) that is capable of facilitating closure of the tool. Further, the ratchet mechanism has a spring (46, figure 6) that biases the handle to the extreme end of its pivotal range, as illustrated in figure 6. The motivation to add the handle would be to release the Nelson ratchet mechanism. The motivation to add the Nelson ratchet mechanism to the Burke device would be to allow the tool to automatically stay in a partially closed position. At the time of the invention it would have been obvious to one of ordinary skill in the art to add the Nelson ratchet mechanism and handle to the Burke device for the purpose of allowing the tool to automatically stay in a partially closed position.
11. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke in view of Petersen US 4,541,312. The Burke device discloses the crimping pliers comprising 2 handles and specialized jaws, but does not disclose an auxiliary handle having a U-shaped configuration. Petersen teaches a quick squeeze tool with a U-Shaped handle (28, figure 1) that is capable of facilitating closure of the tool. Further, the Petersen ratchet mechanism has a spring

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(26, figure 1) that biases the handle to the extreme end of its pivotal range, as illustrated in figure

1. The motivation to add the handle would be to release the Petersen ratchet mechanism. The motivation to add the Petersen ratchet mechanism to the Burke device would be to allow the tool to automatically stay in a partially closed position. At the time of the invention it would have been obvious to one of ordinary skill in the art to add the Petersen ratchet mechanism and handle to the Burke device for the purpose of allowing the tool to automatically stay in a partially closed position.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

PR
Paul Roberts
March 27, 2003


MICHAEL J. MILANO
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